

<b><i>Interview Summary</i></b>	Application No.	Applicant(s)
	10/053,872	KALLNER ET AL.
	Examiner Benjamin A. Ailes	Art Unit 2142

All participants (applicant, applicant's representative, PTO personnel):

(1) Benjamin A. Ailes. (3) Andrew Caldwell.

(2) Sanford T. Colb (#26856). (4) \_\_\_\_\_

Date of Interview: 05 June 2007.

Type: a) Telephonic b) Video Conference  
c) Personal [copy given to: 1) applicant 2) applicant's representative]

Exhibit shown or demonstration conducted: d) Yes e) No.  
If Yes, brief description: \_\_\_\_\_

Claim(s) discussed: 1,4-16,26,29-41,56 and 59-71.

Identification of prior art discussed: \_\_\_\_\_.

Agreement with respect to the claims f) was reached. g) was not reached. h) N/A. *(AC)*

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

ANDREW CALDWELL  
SUPERVISORY PATENT EXAMINER

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

\_\_\_\_\_  
Examiner's signature, if required

## Summary of Record of Interview Requirements

### **Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record**

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

### **Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews Paragraph (b)**

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

### **Examiner to Check for Accuracy**

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The sufficiency of the declaration filed 06 February 2007 and the attached draft remarks were discussed. The examiner indicated that a new declaration is required. With respect to the issue of conception of the dependent claims, the examiner indicated that the new declaration must state that the dependent claims are obvious variants of claims 1 and 4. With respect to the issue of diligence, the examiner indicated that the new declaration must refer to specific pages, sections, and dates of Exhibit B in order to explain the facts that establish diligence.

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Application of : **KALLNER, et al.**

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Serial No.: 10/053,872 : Group Art Unit: 2142  
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Filed : January 24, 2002 : Examiner: Benjamin A. Ailes  
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For : COMMUNICATION ENDPOINT SUPPORTING MULTIPLE  
PROVIDER MODELS

June 5, 2007

**DRAFT REMARKS ON OFFICIAL ACTION - NOT FOR ENTRY**

Honorable Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

In response to an Official Action dated March 23, 2007, Applicants respectfully submit the following remarks for discussion in an interview with the Examiner.

Claims 1, 4-13, 15, 16, 26, 29-38, 40, 41, 56, 59-68, 70 and 71 were rejected under 35 U.S.C. 103(a) over Smyk et al. (U.S. Patent 6,597,686) in view of Gaus (U.S. Patent 6,778,652), and further in view of Klein (U.S. Patent 6,999,448), while claims 14, 39 and 69 were rejected over these three references and further in view of Hetz (U.S. Patent 6,185,289).

In response to this rejection in the previous Official Action in this case; Applicants submitted a Declaration under 37 C.F.R. 1.131 with supporting evidence proving that they conceived the invention recited in the claims of the present patent application prior to March 14, 2000, and worked diligently to reduce the invention to practice from a date prior to March 14, 2000, until the invention was actually reduced to practice and tested successfully on or about June 21, 2000. Klein was filed March 14, 2000, after the date of conception of the present invention. The present Declaration relied in part on a previous Declaration and evidence (including source code) that Applicants submitted proving that the invention was actually reduced to practice on or about June 21, 2000. Therefore, Applicants argued that Klein is ineffective as a reference against the present patent application.

In the present Official Action, the Examiner held the Declaration to be inadequate on two grounds:

- 1) Although the present Declaration was sufficient to prove conception of claim 1 prior to March 14, 2000, it did not prove conception of the remaining claims.
- 2) The evidence of diligence between March 14 and June 21, 2000, was insufficient because it "failed to show specifically within Exhibit B... when the relevant classes were actually updated and how they relate to the previously filed source code."

With respect to the first grounds, Exhibit A submitted with Applicants' present Declaration does support prior conception of at least some of the dependent claims, including at least claim 4. (See, for example, Figure 3 on page 4 of Exhibit A.) With regard to the remaining dependent claims, MPEP 715.02(I) states:

Where a claim has been rejected under 35 U.S.C. 103 based on Reference A in view of Reference B, with the effective date of secondary Reference B being earlier than that of Reference A, the applicant can rely on the teachings of Reference B to

show that the differences between what is shown in his or her 37 CFR 1.131 affidavit or declaration and the claimed invention would have been obvious to one of ordinary skill in the art prior to the date of Reference A. However, the 37 CFR 1.131 affidavit or declaration must still establish possession of the claimed invention, not just what Reference A shows, if Reference A does not teach the basic inventive concept.

In the present Official Action, the Examiner cited Klein's disclosure specifically only against claims 1 and 4 (and the parallel apparatus and software claims). The Examiner held claims 5-16 to be obvious based on teachings in Smyk, Gaus or Hetz, without further reference to Klein. Therefore, according to the Examiner's position and the instructions in MPEP, Applicants' proof of conception of the invention of claim 1 should be sufficient to swear behind claims 5-16. (These arguments hold as well, of course, for the corresponding apparatus and software product claims.)

With respect to the second grounds - evidence of diligence, the software classes submitted in Annex A to Applicants' previous Declaration were selected classes of a software package called "package com.ibm.hrl.jtapi," which was created to implement the present invention. (See paragraph 3 in that Declaration and the first line of Annex A.) The version control listing in Exhibit B to Applicants' present Declaration applies to the entire HRL\_JTAPI package. Therefore, all dates in this exhibit are relevant to showing diligence, and not only the dates of the selected classes in Annex A (which are also represented in the version control listing). There is an ample distribution of dates during the critical between March 14 and June 21, 2000.

Thus, on the basis of Applicants' Declaration, Klein is not applicable as prior art against the present patent application, and the rejections under 35 U.S.C. 103(a) should be withdrawn.